REMARKS

Status of the Claims

Claims 6 and 8-11 have been amended. Specifically, claim 6 has been amended to clarify terms that were rejected under U.S.C. § 112, first and second paragraphs. Claims 8-11 have been amended to clarify terms that were considered indefinite in the Office Action. Support for the amendments resides in the specification and within the claims as discussed below.

Claims 6, 8-11, 29, and 30 are now pending. Reexamination and reconsideration of the claims are respectfully requested. The Examiner's remarks in the Office Action are addressed below in the order set forth therein.

Objections to the Specification

The Office Action notes that priority under 35 U.S.C. § 120 requires a specific reference if the Applicants desire to claim priority to a previous co-pending application. Applicants have therefore added a paragraph with the appropriate priority information. The amendment is a proper claim to priority, as reflected in the record and in item 4 of the Divisional Application Transmittal filed concurrently with the above-identified application on September 18, 2001. Thus no new matter is added by way of amendment.

The Office Action objects to the Abstract of the Invention because it does not adequately describe the claimed invention. The abstract has been amended to recite a method of treatment for an "IgE-mediated allergic disease." Support for this amendment is found in the specification on page 5, lines 5-11, and page 11, lines 26-28. This amendment obviates the objection because it describes the claimed invention, and thus the objection should be withdrawn.

The Office Action objects to an obvious typographical error in the Abstract of the Invention. The abstract has been amended to recite a method of treatment for an "IgE-mediated allergic disease." This amendment corrects the typographical error, and thus the objection should be withdrawn.

The Office Action requests correction of other typographical errors and trademarks within the specification. The following amendments correct these obvious errors, and, thus no

new matter is added by way of amendment. Specifically, on page 1 in the paragraph immediately after the heading "Field of the Invention," the spelling of the term "systemic" is corrected. In the paragraph on page 3, line 2, the spelling of the term "differentiation" is corrected. In the paragraph on page 3, line 26, the spelling of the term "effect" is corrected. In the paragraph on page 5, line 12, the spelling of the term "systemic" is corrected. In the paragraph on page 8, line 13, the spelling of the term "or" is corrected. In the paragraph on page 14, line 13, the spelling of the term "parenteral" is corrected. In the paragraph on page 17, line 5, the citation to Banchereau *et al.* is corrected. In the paragraph on page 18, line 28, the use of a trademark is corrected. In the paragraph on page 19, line 7, the use of a trademark and the manufacturer's name is corrected. In the paragraph on page 20, line 18, the spelling of the term "Tris-HCl" is corrected. In the paragraph on page 22, line 2, the grammatical use of the term "washes" is corrected. In the paragraph on page 23, line 2, the spelling of the term "hybridoma" is corrected. In the paragraph on page 24, line 3, the spelling of the term "antibodies" is corrected. In the paragraph on page 25, line 17, the grammatical use of the term "for" is corrected. The amendment to the specification at page 25, line 23, which substitutes "CD40" for "anti-CD40," is fully supported by the disclosures throughout the specification. *See* the specification at page 4, lines 9-11, and Fig. 6. In the paragraph on page 26, line 16, the grammatical use of a parenthesis is corrected. The amendment to the specification at page 29, line 4, merely updates the ATCC's change of address to advise those skilled in the art of the location of Applicants' deposited hybridoma cell line. The amendment to the specification at page 29, line 11, merely identifies the deposit number "HB 12024" and deposit date "January 30, 1996" of Applicants' deposited hybridoma cell line.

The specification is further amended to properly reference the SEQ ID NOs. The amendment to the description of Fig. 1A at page 6, line 3, merely adds the SEQ ID NO and references the nucleotide sequence in Fig. 1 to which it refers. Likewise, the amendment to the description of Fig. 2 at page 6, line 9, merely adds the SEQ ID NOs and references the nucleotide sequences in Fig. 2 to which they refer. The amendments to the specification at page 6, lines 13 and 14, which merely describe each of the three figures (Figs. 4A-4C) of Fig. 4, is supported by the disclosure in each of Figures 4A-4C, respectively. These amendments to the

specification reflect amendments entered in the parent application. No new matter is added by way of these amendments.

The Rejections of the Claims Under 35 U.S.C. § 112, First Paragraph, Should Be Withdrawn

Claims 6, 8-11, 29, and 30 are rejected under 35 U.S.C. § 112, first paragraph, as not being enabled for non-allergic IgE mediated diseases. This rejection is respectfully traversed as applied to the amended claims.

The Office Action notes that treating allergy is enabled. *See*, the Office Action mailed September 30, 2003, at § 8. For purposes of furthering prosecution of this application, claim 6, and necessarily claims dependent thereon, have been amended to recite "IgE-mediated allergic disease." Support for this amendment can be found in the specification, for example, on page 5, lines 5-11, and page 11, lines 26-28. Accordingly, Applicants respectfully submit that this rejection of claims 6, 8-11, 29, and 30 should be withdrawn.

Though not specifically rejected under this statute, claims 6, 8-11, 29, and 30 are objected to because the specification does not recite the complete deposit information for the 5D12, 3A8, and 3C6 antibodies required to practice the invention. *See*, the Office Action mailed September 30, 2003, at § 9. Applicants note that the specification has been amended to recite the new ATCC address, as well as the missing deposit date and ATCC accession number for the hybridoma secreting the 3A8 antibody. Accordingly, Applicants respectfully submit that the 5D12, 3A8, and 3C6 antibodies recited in claims 8-11 can be obtained by the public in compliance with 37 C.F.R. § 1.801-1.809, and this objection should be withdrawn.

The Rejections of the Claims Under 35 U.S.C. § 112, Second Paragraph, Should Be Withdrawn

Claims 6, 8-11, 29, and 30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for not citing the hybridomas' ATCC accession numbers. This rejection is respectfully traversed as applied to the amended claims.

As an initial matter, claim 6 does not recite the rejected terms: "5D12," "3A8," or "3C6." Moreover, claims 29 and 30 depend directly from claim 6 and therefore do not recite these

rejected terms. Accordingly, Applicants respectfully note that this rejection of claims 6, 29, and 30 is improper, and therefore should be withdrawn.

In keeping with the Examiner's suggestion, claims 8, 9, and 10 have been amended to recite the respective ATCC accession numbers for the hybridomas that secrete the 5D12, 3A8, and 3C6 antibodies. Support for this amendment resides in the specification on page 29, lines 2-11. Applicants respectfully submit that these claims are definite, and this rejection of the claims should be withdrawn.

Claims 6, 8-11, 29, and 30 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for recitation of the term "IgE mediated diseases." This rejection is respectfully traversed as applied to the amended claims.

The Office Action notes "allergic" IgE- mediated disease is unambiguous. *See* the Office Action mailed September 30, 2003, at § 9(B). For purposes of furthering prosecution, claim 6, and thus claims 8-11, 29, and 30 directly or indirectly dependent thereon, have been amended to recite "IgE-mediated allergic disease." Support for this amendment can be found in the specification, for example, on page 5, lines 5-11, and page 11, lines 26-28. Accordingly, Applicants respectfully submit that claims 6, 8-11, 29, and 30 are definite, and this rejection of the claims should be withdrawn.

The Rejections of the Claims Under Obviousness-Type Double Patenting Should Be Withdrawn

Claims 6, 8-11, 29, and 30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of commonly owned U.S. Patent No. 6,004,552. A terminal disclaimer in compliance with 37 C.F.R. §1.321(c) is filed concurrently herewith. In view of this submission, Applicants respectfully submit that this rejection is now overcome.

CONCLUSION

In view of the aforementioned amendments and remarks, Applicants respectfully submit that the objections to the specification and the rejections of the claims under 35 U.S.C. § 112,

first and second paragraphs, and obviousness-type double patenting are overcome. Accordingly, Applicants submit that this application is now in condition for allowance. Early notice to this effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned.

It is not believed that extensions of time or fees for net addition of claims are required beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 03-1664.

Respectfully submitted,

Lisa E. Alexander
Attorney for Applicants
Registration No. 41,576

Customer No. 27476
CHIRON CORPORATION
Intellectual Property
P.O. Box 8097
Emeryville, California 94662-8097
(510) 923-2585
(510) 655-3542 (fax)

CERTIFICATE OF EXPRESS MAILING

"Express Mail" mailing label number **EV 351 354 456 US**
Date of Deposit March 29, 2004
I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: MAIL STOP NON-FEE AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

Esperanza C. Licad